

Docket N : SCHMITT-13  
 Serial No.: 10/047,486

## REMARKS

The last Office Action of August 15, 2003 has been carefully considered. Reconsideration of the instant application in view of the foregoing amendments and the following remarks is respectfully requested.

Claims 1-17 are pending in the application. Claim 1 has been amended. Claims 9-17 are withdrawn from further consideration. Applicant hereby affirms the election of claims 1-8. Applicant has canceled non-elected claims 9-17, but reserves the right to file a divisional application or to take such other appropriate measures as deemed necessary to protect the invention as covered by these claims.

It is noted that the disclosure is objected to because of an informality. It is further noted that claim 4 is rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1, 3-5, and 8 stand rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Pat. No. 3,442,008 to Johnson.

Claims 1, 2, and 5-8 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Pat. No. 3,551,999 to Gutmann in view of U.S. Pat. No. 2,317,198 to Kasper.

Claims 1, 2, and 5-8 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Pat. No. 3,371,572 to King, Jr. in view of Kasper.

Dock 1 No.: SCHMITT-13  
Serial N .: 10/047,486

# **REJECTION UNDER 35 U.S.C. §112, SECOND PARAGRAPH**

Applicant has amended claim 4 to address the §112 rejection. This amendment is self-explanatory so that no further discussion is believed to be required.

Withdrawal of the rejection of claim 4 under 35 U.S.C. §112, second paragraph is thus respectfully requested.

# **REJECTION UNDER 35 U.S.C. §102(b) AS BEING ANTICIPATED BY JOHNSON**

The rejection under 35 U.S.C. 102(b) is respectfully traversed.

The present invention is directed to a method by which a rod-shaped part is to be secured within a surrounding holding member. In other words, the method has at its outcome a permanent connection between the rod-shaped part and the holding member, whereby the connection is realized by press-fitting the holding member onto the rod-shaped part. Although original claim 1 is believed to be clear on this point clear, applicant has amended claim 1 to expressly set forth the permanent connection between the holding member and the rod-shaped part on this point. This change is cosmetic in nature and thus does not narrow the claim element to trigger prosecution history estoppel.

The Johnson reference describes a method of manufacturing an electrode. In this method, a rod-shaped member is formed with interlocking

Docket No.: SCHMITT-13  
Serial No.: 10/047,486

members into a flat electrode blank which is rolled over a cylindrical mandrel to produce the electrode. The mandrel assumes here only the function to enable a rolling of the blank and is **not** intended to remain secured to the blank. Thus, Johnson describes merely the manufacture of a single-part product and is not concerned with the manufacture of a two-part product in which a permanent connection is realized between a rod-shaped part and a holding member by the combination of steps, as set forth in claim 1.

For the reasons set forth above, it is applicant's contention that Johnson neither teaches nor suggests the features of the present invention, as recited in claim 1.

Withdrawal of the rejection of claims 1, 3-5, and 8 under 35 U.S.C. §102(b) is thus respectfully requested.

# **REJECTION UNDER 35 U.S.C. §103(a) AS BEING UNPATENTABLE OVER GUTMANN IN VIEW OF KASPER**

The rejection under 35 U.S.C. 103(a) is respectfully traversed.

The Gutmann reference describes a butt-joining method of steel bars, whereby two rods are joined by an external sleeve which is applied thereover and compressed in order to tightly surround the entire circumference and surface of the rods. Gutmann teaches merely the provision of a **finished** sleeve for attachment to rods in end-to-end disposition, and subsequent compression of the sleeve onto the rods.

Docket No.: SCHMITT-13  
Serial No.: 10/047,486

Nothing in Gutmann is mentioned about the manufacture of the sleeve itself. In contrast thereto, claim 1 teaches a combination of steps that involve the fabrication of a flat holding member with particularly configured ends, bending the ends the holding member upwards, shaping the holding member to a cross section to correspond to the cross section of the rod-shaped part, inserting the rod-shaped part into the holding member, and press-fitting the holding member to effect the permanent connection. Thus, claim 1 sets forth particular steps to manufacture the holding member and to connect it to the rod-shaped part, whereby the rod-shaped part is used as the element about which the holding member can be rolled over. As the holding member has an opening, the holding member can be suited to the outer diameter of the rod-shaped part. In Gutmann, an already finished and closed sleeve is compressed onto the rods. As a consequence, the compression results in significant tension in the sleeve during compression, and the inner diameter of the sleeve must be precisely matched to the diameter of the rods to ensure an even securement of the connection during compression.

The Kasper reference describes the provision of a tubing with complementary interlocking dove-tailed recesses and tongues at adjacent opposite ends of the tubing. The Examiner now combines the Gutmann and Kasper references to suggest that the present invention is hereby produced. Applicant respectively disagrees with the Examiner's conclusion that a combination of the Gutmann and Kasper references produces the present invention for the following reason. As stated above, Gutmann merely discloses

Docket No.: SCHMITT-13  
Serial No.: 10/047,486

the provision of a finished and closed tube to connect two rods in end-to-end disposition. Thus, a combination of Gutmann and Kasper will merely result in the provision of the Kasper tubing with the interlocking elements to keep the tubing closed, and placement of the finished and closed tubing onto the adjacent rods. This, however, is not what the inventor of the present invention has contemplated and what is set forth in claim 1. Applicant emphasizes again, that claim 1 teaches particular steps to make a holding member and to securely connect the holding member to a rod-shaped part.

For the reasons set forth above, it is applicant's contention that neither Gutmann nor Kasper, nor a combination thereof teaches or suggests the features of the present invention, as recited in claim 1.

Withdrawal of the rejection of claims 1, 2, and 5-8 under 35 U.S.C. §103(a) is thus respectfully requested.

# **REJECTION UNDER 35 U.S.C. §103(a) AS BEING UNPATENTABLE OVER KING, JR. IN VIEW OF KASPER**

The rejection under 35 U.S.C. 103(a) is respectfully traversed.

The King, Jr. reference discloses a locking bolt with a collar being swaged onto the bolt via a sleeve having a contraction slit for alignment when the collar is swaged around the locking bolt. Apart from the fact that this type of securement is not play-free to transmit forces, the King, Jr. reference also relates merely to an already finished sleeve for compression onto the locking bolt.

Docket N : SCHMITT-13  
Serial No.: 10/047,486

The Examiner combines the King, Jr. and Kasper references to suggest that the present invention is hereby produced. Applicant respectfully disagrees because the Examiner failed to explain the motivation one with no knowledge of applicant's invention would have to combine the references in a manner suggested. While Kasper describes the provision of a tubing with complementary interlocking dove-tailed recesses and tongues at adjacent opposite ends of the tubing to effect a secure connection, King, Jr. expressly desires the provision of a contraction slit at the adjacent ends. It is not clear to applicant why a person skilled in the art would combine the King, Jr. and Kasper references in the manner suggested by the Examiner, unless the artisan uses the claimed invention as an instruction manual or "template" to piece together the teachings of the prior art. This, however, is not permitted and it appears that the Examiner fell into the trap of hindsight to arrive at the determination of obviousness. There is no teaching or suggestion supporting the combination as proposed by the Examiner. The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification. In re Gordon, 733 F.2d at 902.

For the reasons set forth above, it is applicant's contention that neither King, Jr. nor Kasper, nor a combination thereof teaches or suggests the features of the present invention, as recited in claim 1.

Withdrawal of the rejection of claims 1, 2, and 5-8 under 35 U.S.C. §103(a) is thus respectfully requested.

Docket N .: SCHMITT-13  
Serial No.: 10/047,486

## CLARIFICATION AMENDMENT

Paragraph [0010] of the instant specification has been amended as suggested by the Examiner. Claim 1 has also been amended to correct an obvious typographic error.

## CITED REFERENCES

Applicant has also carefully scrutinized the further cited prior art and finds it without any relevance to the newly submitted claims. It is thus felt that no specific discussion thereof is necessary.

## CONCLUSION

Applicant believes that when the Examiner reconsiders the claims in the light of the above comments, he will agree that the invention is in no way properly met or anticipated or even suggested by any of the references however they are considered.

In view of the above presented remarks and amendments, it is respectfully submitted that all claims on file should be considered patentably differentiated over the art and should be allowed.

Reconsideration and allowance of the present application are respectfully requested.

Docket No.: SCHMITT-13  
Serial No.: 10/047,486

Should the Examiner consider necessary or desirable any formal changes anywhere in the specification, claims and/or drawing, then it is respectfully requested that such changes be made by Examiner's Amendment, if the Examiner feels this would facilitate passage of the case to issuance. If the Examiner feels that it might be helpful in advancing this case by calling the undersigned, applicant would greatly appreciate such a telephone interview.

Respectfully submitted,

By: 

Henry M. Feiereisen  
Agent For Applicant  
Reg. No: 31,084

Date: November 17, 2003  
350 Fifth Avenue  
Suite 4714  
New York, N.Y. 10118  
(212)244-5500  
HMF:af